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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,772	09/11/2000	John K. Schneider	13325.0030	4904

7590

06/03/2003

Martin G Linihan Esquire  
Hodgson Russ Andrews Woods & Goodyear LLP  
One M&T Plaza Suite 2000  
Buffalo, NY 14203-2391

EXAMINER
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AHMED, SAMIR ANWAR

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 06/03/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

9/659772

John K. Schneider et al

Examiner

S. Ahmed

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2623

1. New formal drawings are required in this application because Figs 5, 6A, 6B, 6C are not legible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “the stop post and the guide post are of electrically conductive material so that a circuit is completed when the hand is properly in place”, does not reasonably provide enablement for “d) a sensor on at least one of the posts to indicate when the hand is properly in place, wherein the stop post and the guide post are of electrically conductive material so that a circuit is completed when the hand is properly in place” as recited in claim 2. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. As shown in the specification, the embodiment of Figs 1-4, the guide post and the stop post both are of metal and when the finger is properly contacts both an electrical circuit is completed to indicate that the

Art Unit: 2623

finger is properly positioned (page 10, lines 6-10). There is no recitation in that embodiment nor Figs 1-4 show a sensor on at least one of the posts to indicate when the hand is properly in place. Fig. 5 shows an alternative form of guide post with a pressure sensitive membrane type switch 52 located along the surface of guide post which is to be contacted by the finger (page 10, lines 10-13). There is no recitation in that embodiment nor Fig 5 shows wherein the stop post and the guide post are of electrically conductive material so that a circuit is completed when the hand is properly in place.

4. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 2 recites “d) a sensor on at least one of the posts to indicate when the hand is properly in place”, lines 13-14, and “wherein the stop post and the guide post are of electrically conductive material so that a circuit is completed when the hand is properly in place”, lines 2-4. As stated above there is no single embodiment in the specification that supports these limitations in the combination as claimed. The limitations are supported in the alternative in two separate embodiments.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2623

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimoto et al.(U.S. Patent 5,177,802).

As to claim 1, Fujimoto discloses an automatic finger positioning guide for fingerprint scanners comprising:

a) an active scan area on the scanner surface upon which one finger rests [ Fig. 36, shows finger F1 rests under the camera 1914 (active scan area on the scanner surface)] and a non-active area on the scanner surface on which one or more of the other fingers rest to provide stability [Fig. 36, shows finger F2 rests away from the camera 1914 (non-active scan area on the scanner surface)to provide stability] ;

b) a stop post on the scanner surface to indicate how far to place the hand longitudinally thereof [Figs. 36, 37 show touch plate 1910 (stop post on the scanner surface) to indicate how far to place the hand longitudinally] ;

c) a guide post on the scanner surface to assist in positioning the finger laterally [Figs. 36, 37 show finger guide plate 1912 laid between figures F1 and F2 (guide post on the scanner) to assist in positioning the finger laterally]; and

Art Unit: 2623

d) a sensor on at least one of the posts to indicate when the hand is properly in place [Fig. 36, shows sensor 1913 on touch plate 1910 (stop post) to sense when the finger F1 reaches the predetermined input reading location (i.e., the hand properly in place)].

As to claim 3, Fujimoto further discloses, wherein pressure sensitive membrane switches are provided on the stop post and on the guide post [Figs 43A and 43B show sensor 1913 on the touch plate 1910 which actuates the pickup device and start imaging the fingerprint when the finger touches the touch plate 1910 (pressure sensitive switch) and mechanical sensor 2241 on the groove 2218a of the finger guide 2218 (guide post) to sense whether or not the finger guide 2218 is located between the subject finger and adjacent finger].

As to claim 4, Fujimoto further discloses, wherein left-hand and right-hand guide posts and stop posts are provided on the scanner surface (col. 31, line 64-col. 32, line 2, col. 33, lines 30-38).

As to claim 5, Fujimoto further discloses, further including a visual indicator on the scanner operatively connected to the sensor to signal when the hand is properly in place (col. 32, line 63-col. 33, line 23).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Ahmed whose telephone number is (703) 305-9870. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for this Group is (703) 872-9314. Any inquiry of a

Serial Number: 09/659,772

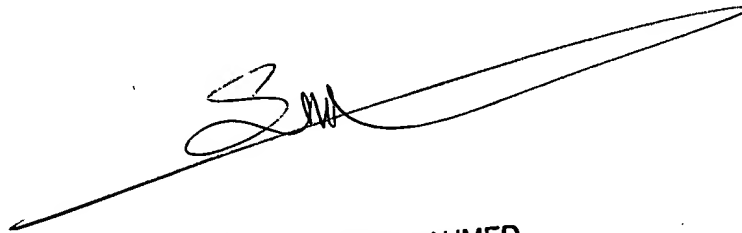
Page 6

Art Unit: 2623

general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SA

5/30/03

A handwritten signature in black ink, appearing to be 'Samir', written over a long horizontal line.

**SAMIR AHMED**  
**PRIMARY EXAMINER**